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09/651,433	08/30/2000	Klaus Hofrichter	80398.P334	2558

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EXAMINER

BELIVEAU, SCOTT E

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 10/06/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/651,433

Applicant(s)

HOFRICHTER ET AL.

Examiner

Scott Beliveau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 August 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Miscellaneous***

1. Please note that the examiner of record for the prosecution of this application has changed.

### ***Oath/Declaration***

2. The newly submitted oath or declaration in compliance with 37 CFR 1.67(a) submitted on 26 March 2003 has been received and is acceptable. With respect to the applicant's remarks pertaining to a "Notice of Missing Parts" not being mailed and the request for a corrected filing receipt, it is believed that a corrected filing receipt is not warranted. With the filing of the new oath, the inventorship did not change, but rather signatures were merely provided that were not originally present.

### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 30 March 2004 was filed after the mailing date of the Non-Final Rejection on 24 December 2003. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Drawings***

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because Figure 6A includes reference character "608" not mentioned in the description. Corrected drawing

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sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "650" (Page 24, Line 9) and "658" (Page 24, Line 10). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

*Specification*

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6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

7. The disclosure is objected to because:

- The reference to “signal source 212” should be amended to reference “signal source 211” in order to be consistent with Figure 2 (Page 9, Line 5);
- The phrase “Interface 304b also includes an optional Internet 304b also includes an option Internet connection 213b . . .” should be amended to read “Interface 304b [also includes an optional Internet 304b] also includes an option Internet connection 213b . . .” in order to be consistent with Figure 3A (Page 12, Lines 18-19);

Appropriate correction is required.

### *Response to Arguments*

8. The OFFICIAL NOTICE stating that it is notoriously well known in the art of video segment presentation to display video segments after those that have been marked as "of interest" in order to offer more viewing material to the viewer after he watches the "of interest" segments was not traversed and is accordingly taken as an admission of fact noted.

9. The OFFICIAL NOTICE stating that it is notoriously well known in the art of video segment interest ratings to indicate through a ratings system the full range of interest, including neutral and disinterest, in order to better quantify the level of interest in the segments was not traversed and is accordingly taken as an admission of the fact noted.

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10. The OFFICIAL NOTICE stating that it is notoriously well known in the art of ordering customized lists/playlists to enable a user to modify the list in order to allow more flexibility for the user was not traversed and is accordingly taken as an admission of the fact noted.
11. Applicant's arguments with respect to claims 1-33 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1, 10, 19, and 27 are rejected under 35 U.S.C. 102(A) as being anticipated by the Merialdo et al. publication (“Automatic Construction of Personalized TV News Programs).

With respect to claims 1, 10, 19, and 27, the Merialdo et al. reference discloses a “computerized method” implicitly implemented via a “dedicated service module” associated with the prototype “apparatus” which utilizes a “computer readable medium having instructions” which when executed by a “processing system” that causes the system to implement the method. Accordingly, the method comprises “dynamically changing a presentation order of a plurality of segments” of a news program “for presentation to a

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viewer based upon one or more bookmark signals received from the viewer” (Keyword-based scheme – User Interaction). In particular, the system “dynamically changes a presentation order of a plurality of segments” in order of expected user interest wherein each segment is “associated . . . with a corresponding teaser” in the form of a representative frame (Figure 9). A user “bookmarks” segments of interest corresponding to the expected segments of interest. The system, subsequently, updates the selection criteria of segments and “dynamically change the presentation order” generate a personalized program.

14. Claims 1, 10, 19, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown et al. (US Pat No. 5,553,281).

With respect to claim 1, the Brown et al. reference discloses a “computerized method” (Col 3, Lines 38-53) comprising a “presentation . . . of a plurality of segments” whereupon the system “receives one or more bookmark signals from the viewer” particularly identifying segments of interest which subsequently “dynamically changes a presentation order of a plurality of segments” (Col 5, Lines 8-19; Col 9, Line 38 – Col 10, Line 7).

Claim 10 is rejected wherein the reference discloses a “computer readable medium having instructions” which when executed by a “processing system” [2] cause the system to implement the method of claim 1 (Col 3, Lines 38-53).

Claim 19 is rejected wherein the reference discloses the usage of an “apparatus” [2] that is operable to implement the method of claim 1 and further comprises a “means for associating each segment with a corresponding teaser” or representative key-frame [62].

Claim 27 is rejected wherein the reference discloses the particular usage of a “dedicated service module” [2] so as to implement the method of claim 1 (Col 3, Lines 38-53).

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15. Claims 1, 10, 19, and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Boreczky et al. (US Pat No. 6,366,296).

With respect to claim 1, the Boreczky et al. reference discloses a “computerized method” (Col 10, Lines 1-29) comprising a default “presentation . . . of a plurality of segments” whereupon the system “receives one or more bookmark signals from the viewer” particularly identifying segments with metadata so as to “dynamically changing a presentation order of a plurality of segments” upon subsequent playback (Col 3, Line 61 – Col 4, Line 9; Col 4, Line 61 – Col 5, Lines 6 and 38-55). For example, a user may designate a “segments” containing a particular speaker and subsequently “dynamically” change the order of the original presentation by only playing back those segments comprising the speaker or other feature of interest.

Claim 10 is rejected wherein the reference discloses a “computer readable medium having instructions” which when executed by a “processing system” [110] cause the system to implement the method of claim 1 (Col 10, Lines 1-29).

Claim 19 is rejected wherein the reference discloses the usage of an “apparatus” [110] that is operable to implement the method of claim 1 and further comprises a “means for associating each segment with a corresponding teaser” [210] (Col 12, Lines 8-22). The claim does not particularly require that the “corresponding teasers” are necessarily different from one another.

Claim 27 is rejected wherein the reference discloses the particular usage of a “dedicated service module” [111] so as to implement the method of claim 1 (Col 10, Lines 1-29).



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16. Claims 1-6, 10-15, 19-23, and 27-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Dunn et al. (US Pat No. 5,861,906).

With respect to claim 1, the Dunn et al. reference discloses a “computerized method” (Col 6, Lines 6-10) that is operable to “dynamically change a presentation order of a plurality of segments for presentation to a viewer based on one or more bookmark signals received from the viewer”. In particular, the system displays a default “presentation . . . of a plurality of segments” to the viewer (Col 6, Lines 26-36). The system subsequently “receives one or more bookmark signals from the viewer” [80/122], thereby “dynamically changing a presentation order of a plurality of segments” such that the “segments” associated with the newly created list are “dynamically ordered” (ex. added to the top of the list, added to the bottom of the list, etc.) and subsequently displayed at a selected rate (Col 8, Lines 16-23; Col 10, Lines 57-63) in new order as opposed to the original order (Col 6, Lines 21-35).

For example, a user may originally view a continuously looping sequence of “new release” titles in a representative order of title 1, title 2, title 3, title 4, title 1, title 2, etc. While watching these “segments”, presuming that the user adds or “bookmarks” title 1 and title 3. The resulting presentation upon the user choosing to review the customized list would result in a “dynamic change in a presentation order” in wherein the newly presented continuously looping sequence results in a presentation order of title 1, title 3, title 1, title 3, etc. Accordingly, the original order of previews did not present title 3, both before and after title 1. Furthermore, a user may choose to go back and “bookmark” another title to be added to the list either originally or not originally present on the “default loop” further changing the presentation order.

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Claim 10 is rejected wherein the reference discloses a “computer readable medium having instructions” [38] which when executed by a “processing system” [26] cause the system to implement the method of claim 1 (Col 6, Lines 6-12).

Claim 19 is rejected wherein the reference discloses the usage of an “apparatus” [26] that is operable to implement the method of claim 1 and further comprises a “means for associating each segment with a corresponding teaser” (Col 9, Lines 5-7).

Claim 27 is rejected wherein the reference discloses the particular usage of a “dedicated service module” [38] so as to implement the method of claim 1 (Col 6, Lines 6-10).

Claims 2, 11, and 20 are rejected wherein the claimed association of the teasers and video segments is met by the join table that correlates the full length program IDs with the associated preview clip IDs (Col 9, Lines 5-7).

Claims 3, 12, 20, and 28 are rejected wherein the claimed sequential presentation of the teasers is met by the reference's disclosure of the headend transmitting video previews in sequential order, according to the order shown in the displayed list (Col. 10, Lines 38-40).

Claims 4, 5, 13, 14, 21, 22, 29, and 30 are rejected wherein the claimed viewer's signal indicating interest, during the presentation of a teaser is met by the reference's disclosure of the viewer browsing trailers, clicking an "add to list" button, and having the program ID added to a customized viewer list (Col 6 Line 66 – Col 7, Line 3).

Claims 6, 15, 23, and 31 are rejected wherein the claimed presentation of video segments in the new order is met by the ordering of the video segments in the order shown in viewer list in Figure 5.

*Claim Rejections - 35 USC § 103*

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

19. Claim 7-9, 16-18, 24-26, 32, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn et al. (US Pat No. 5,861,906), in view of applicant's admission of fact.

As to claims 7, 16, 24, and 32, Dunn teaches everything, as discussed above, except the presentation of non-bookmarked segments after bookmarked segments. It is notoriously well known in the art of video segment presentation to display video segments after those that have been marked as "of interest" in order to offer more viewing material to the viewer after he watches the "of interest" segments, as evidenced by applicant's admission of fact.

Therefore, it is submitted that it would have been obvious to one of ordinary skill in the art at

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the time the invention was made to add that functionality to the Dunn et al. system in order to generate more revenue.

With respect to claims 8, 17, 25, and 33, the Dunn et al. reference discloses further enabling a viewer “during the presentation of a given teaser” to “send one or more bookmark signals from the group consisting of a negative signal to indicate that the viewer is not interested in the segment” [122] such that the viewer is operable to remove an item from the list. The claim does not require that the “one or more bookmarks” is necessarily the same as that required by claim 1. Assuming arguendo, the claim would not be enabled by the specification in so far as the negative bookmarked segments are displayed at the end of the list contrary to that required by claims 7, 16, 24, and 32.

As to claims 9, 18, and 26, Dunn teaches everything, as discussed above, except the modification of the order of the customized list. It is notoriously well known in the art of ordering customized lists/playlists to enable a user to modify the list in order to allow more flexibility for the user, as evidenced by applicant’s admission of fact. Therefore it is submitted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow for modification of the lists/playlists of the system in order to increase user viewing pleasure.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of

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claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Krapf (US Pat No. 6,483,986) reference discloses a system and method for bookmarking streaming video data.
- The Jain et al. (US Pat No. 6,463,444) reference discloses a system and method for real-time metadata generation so as to facilitate the cataloging video programming.
- The Jain et al. (US Pat No. 6,144,375) reference discloses a system and method for bookmarking scenes and playing back a presentation from that scene.
- The Sezan et al. (US Pat No. 6,236,395) reference discloses the particular usage of metadata so as to develop customized versions of programs based upon user preferences.
- The Milewski et al. (US Pat No. 6,289,346) reference discloses a system and method for bookmarking and retrieving archived video segments.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to

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37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907. The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SEB  
October 1, 2004



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